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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,569	07/22/2003	Akiko Miyano	Q76408	6558
23373	7590	09/27/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/623,569	MIYANO ET AL.
Examiner	Art Unit	
Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 07/20/2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: *Surlyn Resins by Dupont* .

## DETAILED ACTION

### *Objection to the Specification*

1. In the office action dated 04/20/05, the examiner has objected the disclosure because of the following informalities: On Page 16, last paragraph instead of "while", it should read white. The applicant has amended the specification in his/her response dated 07/20/05 and has therefore overcome the objection.

### *Applicant's Arguments*

2. The applicant's arguments made in response to the office action dated 04/20/05 are found to be persuasive. The examiner is withdrawing the rejection of claims 1-5 and 7-9 under U.S.C 102 (b) and the rejection of claim 6 under U.S.C 103(a).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6,7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (US Patent 5,468,532).
4. Ho et al. teach a multilayer graphic article comprising a substrate, at least one color layer disposed on the substrate, and a protective surface layer that overlies the

substrate and the color layer (see Abstract). The multilayer graphic article may be applied to a wide variety of substrates including motor vehicles, marine craft, snowmobiles, sign faces an the like (Column 2, lines 35-37). In one embodiment the multilayer graphic article 10 of Ho et al. comprise a first color layer 12 and a second color layer 14 disposed on a substrate such as a polymeric film layer 16. A clear protective film surface layer 18 overlies both film layer 16 and color layers 12 and 14. Graphic article 10 further comprises an adhesive layer 20 and a temporary, removable liner 22 that protects the adhesive (Column 3, lines 8-16). Additionally, Ho et al. teach that there can be more than one color layer present in the graphic article (Column 3, lines 18-22). Thus there can be three color layers in the multilayer graphic article of Ho et al. The examiner is equating the substrate of Ho et al. as the supporting substrate and the color layers of Ho et al. as the claimed substrate. Multilayer graphic article of Ho et al. can be used as the claimed pressure sensitive adhesive tape. According to Ho et al., particularly preferred substrate includes Surlyn™ family of materials available from E.I. Dupont de Nemours & Co (Column 5, lines 61-63). Note that the Surlyn™ brand films are transparent (please see "Surlyn® Properties and Performance Overview"). Hence, with respect to the claim 3, the substrate of Ho et al. is transparent.

5. Ho et al. teach that the color layer comprises color agents including black, white, and metallic such as aluminum flakes (Column 4, lines 55-58). Note that the use of the aluminum flakes will allow a skilled artisan to form a silver layer.

6. With respect to claims 1-3, 6, and 9, although, Ho et al. do not explicitly teach that the claimed order of the color layers (black-silver-white) as claimed by the

applicant, however in the absence of showing criticality, it is obvious that a skilled artisan can choose to make the color layers of Ho et al. to be a white layer, a color of layer other than black or white (i.e. silver), and a black layer.

7. The claim 7 is an intended use claim. Thus a skilled artisan can obviously use the graphic article of Ho et al. and fix a liquid-crystal display unit to a backlight unit.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (US Patent 5,468,532) in view of Dobashi et al. (US Patent 5,643,676).

9. In addition to previously disclosed matters of the invention of Ho et al., in one embodiment of Ho et al., a multilayer graphic article 24 comprises a first color layer 12, a second color layer 14, a polymeric film layer 16, a transparent protective surface layer 18, a adhesive layer 20, and a removable liner 22. Additionally, Ho et al. teach that in aforementioned embodiment, the color layers 12 and 14 are positioned below the polymeric film layer 16 and such construction is referred to as a "buried graphic". Buried graphics afford underlying color layers 12 and 14 additional protection against environmental weathering, chemical exposure and abrasion (Column 7, lines 30-42). Ho et al. are silent with respect to teaching a white substrate. The examiner is equating the polymeric film layer 16 as the claimed supporting substrate.

10. Dobashi et al. teach a coating protective film with a colored substrate and a pressure sensitive adhesive layer (see Abstract). The protective film is used in temporarily protecting the automotive coating (Column 1, lines 5-8). Dobashi et al. use a white colored substrate. Furthermore, the use of the white colored substrate helps in

reflecting the light and prevents the increase in the temperature (Column 10, lines 21-23).

11. Thus a skilled artisan would have found it obvious use the white colored substrate of Dobashi et al. as a polymeric film layer in the multilayer graphic article of Ho et al., motivated by the desire to protect the underlying color layers and hence increase the durability of the multilayer graphic article of Ho et al.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-4,6, and 16-18 of copending Application No. 11/041,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4,6, and 18 disclose a black layer, a silver layer, and a white layer. Claims 16 and 17 disclose a liquid-crystal display module unit and a backlight unit.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

  
ELIZABETH M. COLE  
PRIMARY EXAMINER